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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,087

05/29/2002

Stefan Disch

1999/G-017

9098

7590

04/05/2004

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Wilmington, DE 19899

EXAMINER

RAJGURU, UMAKANT K

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,087

Applicant(s)

DISCH ET AL

Examiner

Umakant K. Rajguru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 & 11-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claims 1-3 and 11-26 are presented for examination.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague in reciting, "essentially consisting of ". The proper phrase is either "consisting ~~essentially~~ of ". or "consisting essentially of ".

Same is the case with claim 15.

Claim 1 is also indefinite in referring to "the colored molding composition" when there is no such colored molding composition.

Claims 12, 13, 19, 20, 23 & contain the trademark/trade name VDA 274. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe formaldehyde emission and, accordingly, the identification/description is indefinite.


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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pitt et al (US 5476653).

 Pitt discloses polyoxymethylene-oxyeth~~ylene~~<sup>ylene</sup> copolymers. The polymer was prepared using trifluoromethanesulfonic acid as catalyst (col. 7, lines 11-14).

Claim 1 therefore lacks novelty.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt et al (US 5476653) or Muck et al (US 5994455).

Pitt does not furnish any information about extents of emission of formaldehyde. It is the examiners position that copolymers of Pitts obvious satisfy limitation.

Muck discloses a process for preparation of polyoxymethylene copolymers. A ~~strong~~ strong protonic acid is used as an initiator (col. 2, line 22-29). ~~Like Pitt,~~ Muck is silent on extent of formaldehyde emitted.

It would have been obvious follow Pitt or Muck and arrive at instant invention.

8. Claims 2, 3, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt et al (US 5476653) or Muck et al (US 5994455) as applied to claim 1 above, and further in view of Kosinski (EP 448037) and Chapman et al (US 3656982).

Neither Pitt nor Muck mentions colorants (of claims 2 & 3)

~~Kosinsky~~ Kosinsky describe polyacetal compositions, which can include other useful ingredients such as pigments, colorants, stabilizers etc. (page. 12, lines 49-34).

~~Chapman~~ Chapman discloses pearlescent pigment. Such as a pigment is used ~~after~~ after coating it with 1% calcium stearate (col. 6, lines 8-9).

Therefore it would have been obvious to admix appropriate colorant/s or pigment/s with the copolymers of Pitt or Muck and also to coat these colorant/s or pigment/s with alkali metal salt in order to impart color, hiding power and enhanced luster as well as appearance to the molded product/s made out of the copolymers™

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muck et al (US 5994455) or Pitt et al (US 5476653) as applied to claim 1 above, and further in view of Yokoyama et al (US 5952410).

Muck and Pitt are silent about the amount of oxymethylene units.

Yokoyama discloses polyacetal resin composition. In col. 6, lines 16-30, patentee discusses the influence of respective amounts of oxmethylene and oxyethylene units in the copolymer on the melting temperature of the copolymer.

*NR* Hence based on teaching of Yokoyama one would obviously be led to choose the claimed mol% of oxymethylene units in order to adjust the melting point as required for easy processing.

10. Claims 15-18,21,22,25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muck et al (US 5994455) or Pitt et al (US 5476653) each in view of Kosinski et al (US 5952410), Chapman et al (US 3656982) and Yokoyama et al (US 5952410)

Please see item 8 (above) for the gist of this rejection.

It is noted that prior art is silent about limitations of instant claims 12,13,19,20,23 and 24. It is the examiners position that since prior art discloses composition containing ingredients (a) which read on the claimed ones and (b) in amounts that are similar to or overlap those that are instantly claimed, it is reasonable to infer unless proved otherwise, that the composition of prior art obviously satisfies limitations of above claims.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru, whose telephone number is (571) 272-1077. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



U. K. Rajguru/af  
March 26, 2004



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700